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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,768	07/06/2000	William P. Alberth JR.	CS10557	5526

7590 10/09/2003

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EXAMINER

TRAN, TUAN A

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,768

Applicant(s)

ALBERTH ET AL.

Examiner

Tuan A Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10,14-24,27 and 30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,11-13,26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 4 and 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Alpert (5,742,666).

Regarding claims 4 and 12, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device after a call is established (See col. 5 lines 15-20); monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked –up by the microphone of the wireless device (See col. 5 lines 20-23, col. 10 lines 43-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 13, 26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666) in view of Shirk et al. (6,539,301).

Regarding claims 1-2, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device and sending position data from the wireless device after a call is established (See col. 5 lines 15-20, col. 5 line 55 to col. 6 line 5); and monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked up by the microphone of the wireless device (See col. 5 lines 20-23, col. 10 lines 43-46).. However, Alpert does not mention the step of sending the stored message when a predetermined time has elapsed on a timer wherein the timer is initiated when the call is established. Shirk teaches about an assistance request system (See figs. 3A and 4) including a timer function that required a user press a request button for a minimum time period before a request is initiated (See fig. 4 and col. 2 lines 23-30). Since both Alpert and Shirk suggest systems capable of sending assistance request to a receiving party automatically, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of timer function of Shirk in delaying to send the stored message to

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the receiving party from the wireless device as disclosed by Alpert for the advantage of minimizing inadvertent or mistaken service request.

Claims 26 and 28 are rejected for the same reasons as set forth in claim 1, as apparatus.

Regarding claim 13, Alpert & Shirk disclose as cited in claim 1. Alpert further discloses the step of terminating sending the stored message when a key of the wireless device is activated (See col. 10 lines 47-49).

Claim 29 is rejected for the same reasons as set forth in claim 13, as apparatus.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666).

Regarding claim 11, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device after a call is established (See col. 5 lines 15-20); monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked up by the microphone of the wireless device (See col. 5 lines 20-23, col. 10 lines 43-46). However, Alpert does not mention that the data message including a digital signature. Data message having digital signature is well known in the art (See U.S. Patent 6,487,542 col. 10 lines 5-11), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to have included digital signature into the transmitted data message as disclosed by Alpert in order to enhance the validity of the message.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ebata et al. (6,487,542) discloses method and apparatus for managing electronic money and storage for storing an electronic money management program.

Allowable Subject Matter

4. Claims 6-7 and 23-24 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claims 6 and 23, the prior art, that is closest to the claimed subject matters, is Alpert. Alpert discloses a method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of: initiating a call from the wireless device; sending the stored message from the wireless device after a call is established; and replaying the message continuously over to the receiving party. However, Alpert fails to teach the step of detecting a playback command received from the base, in response to the operator of the base depressing a keypad key.

Claims 7 and 24 are allowed as being dependent upon independent claims 6 and 23 respectively, which have been allowed.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed 07/23/2003 have been fully considered but they are not persuasive.

a. The Applicant argued that Alpert teaches the termination of sending a message only after a specific key or key sequence is additionally depressed, and speaking into a microphone will not terminate the sending of the message (See Remark, page 8 third paragraph). The Examiner respectfully disagrees with the Applicant's argument because Alpert does teach the steps of monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked up by the microphone of the wireless device (See col. 5 lines 20-23 and col. 10 lines 43-46). For that reasons, the Examiner remains the same rejections.

b. The Applicant argued that Shirk et al. fails to teach and/or make obvious a time which is initiated when the call is established and Alpert and Shirk et al. either alone or in combination fail to make known the claims of the present invention (See Remark, page 9 first paragraph). Examiner recognized that the Applicant should

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consider the references as a whole since the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In this case, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device and sending position data from the wireless device after a call is established (See col. 5 lines 15-20, col. 5 line 55 to col. 6 line 5); and monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked up by the microphone of the wireless device (See col. 5 lines 20-23, col. 10 lines 43-46).. However, Alpert does not mention the step of sending the stored message when a predetermined time has elapsed on a timer wherein the timer is initiated when the call is established. Shirk teaches about an assistance request system (See figs. 3A and 4) including a timer function that required a user press a request button for a minimum time period before a request is initiated (See fig. 4 and col. 2 lines 23-30). Since both Alpert and Shirk suggest systems capable of sending assistance request to a receiving party automatically, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of delaying to send the stored assistance request message to the receiving party for a predetermined period of time of Shirk in modifying the wireless device as disclosed by Alpert by having included a timer to delay the sending of the stored message after the call is established, for the advantage of minimizing inadvertent

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or mistaken service request. For that reasons, the Examiner respectfully disagrees with the Applicant's arguments and remains the same rejections.

c. The Applicant argued that the Examiner failed to provide a specific teaching that would motivate one to modify the teachings of Alpert for purposes of making obvious claim 11 (See Remark, page 9 third paragraph). To reply to the Applicant's arguments and further to support the Examiner's statement "data message having digital signature is well known in the art", the Examiner would like to present U.S. Patent 6,487,542 issued to Ebata as evidence for the Examiner's assertions (See fig. 6 and col. 10 lines 5-11). Since data message having digital signature is well known in the art, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included digital signature into the transmitted data message as disclosed by Alpert in order to enhance the validity of the message. For that reasons, the Examiner remains the same rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(703) 605-4255**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(703) 308-6739**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

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Tuan Tran

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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

10/6/03